

## REMARKS

### A. Current Submissions

All of the claims previously submitted have been canceled in favor of the eight new claims 24-31; claims 24-26 and 31 are to a commercial garlic seasoning product, while claims 27-30 are to a process for making that product.

Submitted herewith in support of the allowance of the claims is the Second Declaration of the inventor John Layous.

### B. Applicant's Invention

Applicant's novel garlic seasoning product is capable of being commercially produced and distributed in a form that can be stored and dispensed from a shaker. Further, the garlic seasoning of the invention is crispy and crunchy and imbues foods to which it is applied with a roasted garlic flavor at a strength that can be widely accepted. No prior art citation discloses a similar or equivalent product.

### C. Applicant's Invention Is Both Superior and Materially Different From The Prior Art

In *In re Levin*, 84 USPQ 232, 234 (CCPA 1949), cited by the Examiner, the court's holding includes a test that actually supports the patentability of Applicant's invention. The invention in *In re Levin* was predicated solely on the degree of acidulation in an otherwise known composition of matter. In reaching its holding, the court stated that this sole distinction did not "define a . . . composition of matter that is superior or materially different from the disclosures of the art of record,". It follows that where a composition of matter

is superior or materially different from the prior art, it will support patentability. Applicant will show that its claimed garlic seasoning product and process are both superior and materially different from the prior art.

D. Claim Limitations

Applicant's new claims 24-26 and 31, which recite much more than the mere increase of one known ingredient as was the fact in *In re Levin, supra*, set forth a composition of matter that is both superior and materially different from the cited art. New claims 27-30 are directed to the process for making the novel product of claims 24-26.

All of the newly submitted claims include the following material limitations:

- (1) generally uniformly thick pieces of garlic derived by slicing different sized cloves of raw garlic;
- (2) are crispy and crunchy;
- (2) have a roasted garlic flavor;
- (3) are sized to be stored and dispensed from a shaker;
- (4) imbue foods to which they are applied with a roasted garlic flavor; and
- (5) have a generally uniform strength of garlic flavor that is reduced from the strength of garlic flavor of the raw garlic from which they are derived and from the strength of garlic that is only fried.

The following additional limitations appear in dependant claims as indicated;

- (6) reducing bitterness (25);

- (7) garlic pieces are between approximately 1/16 and 3/16 of an inch thick (26, 30);
- (8) reducing step by blanching in hot water (28); and
- (9) reducing step by baking (29).

When these material limitations of Applicant's claimed invention are fairly compared with the products and processes of the cited art, it becomes manifest that Applicant's invention is "superior" (for its intended purpose) and "materially different from the disclosures of the art of record." *In re Levin*, Id.

E. The Cited References Compared

Meiji teaches whole garlic cloves from which "the odour of garlic is *completely* eliminated." Because the Meiji process completely deodorizes whole garlic cloves which are not sliced or cut, the end product does not have the following material characteristics of Applicant's claimed invention:

- (1) generally uniformly thick pieces of garlic derived by slicing different sized cloves of raw garlic;
- (2) are crispy and crunchy;
- (2) have a roasted garlic flavor;
- (3) are sized to be stored and dispensed from a shaker;
- (4) imbue foods to which they are applied with a roasted garlic flavor; and
- (5) have a generally uniform strength of garlic flavor that is reduced from the strength of garlic flavor of the raw garlic from which they are derived and from the strength of garlic that is only fried.
- (7) garlic pieces are between approximately 1/16 and 3/16 of an inch thick

(26, 30);

(9) reducing step by baking (29).

It is beyond serious dispute that Applicant's claimed garlic seasoning product is different than and superior to (as a seasoning) Meiji's odorless garlic cloves.

Rombauer teaches that whole cloves (not slices) of garlic are blanched before being simmered in butter and minced (sliced and chopped into very small pieces). Blanching the clove while whole produces an uneven strength of garlic flavor throughout the clove such that different portions of the minced garlic will have different strengths of garlic flavor. See Second Layous Declaration (SLD) ¶¶ 6, 11. This lack of uniformity is not a problem for Rombauer's process, which adds the minced garlic directly to a sauce where the uneven strength of garlic flavor is evened out by cooking and dispersement throughout the sauce. SLD ¶ 11. But where garlic slices are to be fried, stored in a container and dispensed from the container (such as a shaker) onto food as a seasoning, as is Applicant's invention, uniformity is a highly desired characteristic, as it is with all condiments used to flavor food. SLD ¶ 8. Inconsistency would be a cook's nightmare; not knowing how much seasoning to apply from one application to the next.

Furthermore, Rombauer does not teach pieces of fried and dried garlic that can be added to food from a shaker, much as one would add salt or pepper, wherein the garlic pieces are generally uniform in thickness, and:

- are crispy and crunchy;

- have a roasted flavor; or
- are sized to be stored and dispensed from a shaker.

SLD ¶ 12.

It is beyond serious dispute that Applicant's claimed garlic seasoning product is different than and superior to (as a commercial seasoning) Rombauer's minced and simmered garlic.

Sakamoto is directed to "Furnace Construction for Drying Garlic." Like Meiji, Sakamoto is concerned with the health benefits of garlic and, in particular, with the loss of volatile elements of garlic during baking. Sakamoto explains that prior art baking methods and apparatus cause scratches on the surface of the garlic cloves and these scratches result in a substantial loss of volatile elements. The entire patent is devoted to working with whole cloves of garlic in a way that does not permit the escape of volatile elements. Nothing could be more contrary to Sakamoto than slicing the garlic cloves before processing, as taught by Applicant. SLD ¶13.

After being baked in the furnace vessel taught by Sakamoto, the garlic cloves are taken out of the vessel and *pulverized*. (Col. 1, lines 71-72.) The end result (powdered garlic) has none of the physical characteristics of Applicant's invention: thin pieces of garlic (sliced from whole garlic cloves of different sizes) of generally uniform thickness which:

- are crispy and crunchy;
- have a roasted flavor; or
- have a generally uniform strength of garlic flavor that is reduced from the

strength of garlic flavor of the raw garlic from which they are derived.

SLD ¶ 14.

It is beyond serious dispute that Applicant's claimed garlic seasoning product is different than and superior to (as a commercial seasoning) Sakamoto's furnace or the powdered garlic it produces.

Regardless of the purpose for which these referenced were cited, Applicant's invention is, as demonstrated above, superior to (for the purpose intended), and "materially different from, the disclosures of the art of record." As such, it is entitled to patent protection according to *In re Levin, supra*, at 234.

F. The Combination of Meiji and Rombauer - 103 Rejection - Is Improper and Ineffective

The rejection based on the combination of Meiji and Rombauer is predicated on the assertion that Meiji teaches all of the claim limitations except "cutting the garlic into bits." This can no longer be said with regard to the newly submitted claims.

The new claims all call for the following characteristics (limitations) not found in Meiji:

Thin pieces of garlic (sliced from whole garlic cloves of different sizes) of generally uniform thickness which:

- are crispy and crunchy;
- have a roasted flavor;
- are sized to be stored and dispensed from a shaker;
- imbue foods to which they are applied with garlic flavor; or

- have a generally uniform strength of garlic flavor that is reduced from the strength of garlic flavor of the raw garlic from which they are derived.

In order for Meiji to meet the limitations of the new claims, it would be necessary for Meiji to slice the garlic into uniform slices before blanching if it wanted to achieve a uniform reduction in garlic flavor. Since Meiji eliminates all of the garlic flavor, it does not need to worry about uniformity of garlic flavor and, thus, the slicing step would be a wasted effort. In addition, the slicing step would cause Meiji to abandon its goal of preserving the cells of the garlic. It is also worth noting that the reaction to frying under reduced pressure, as called for by Meiji, is quite different in the case of thin slices and whole cloves.

In order for Meiji to meet the limitations of the new claims, it would also be necessary for Meiji to produce an end result that would imbue food with a garlic flavor. This would require that Meiji abandon its mission of completely eliminating the garlic odor.

In order for Meiji to meet the limitations of the new claims, it would further be necessary for Meiji to produce an end result that was not only crispy and crunchy, but also of a size that could be stored and dispensed from a shaker onto food.

Meiji actually teaches *away* from Applicant's invention by requiring processing without first cutting and eliminating the garlic odor completely. Meiji eliminates all of the garlic odor because its product is not intended to flavor food and it specifically teaches not to cut the cloves before blanching in

order to preserve the cells that Meiji's invention is expressly designed to protect. Thus, not only does Meiji not teach Applicant's claimed process or product, it is not reasonable to contemplate modifying Meiji by adding the step of cutting the garlic cloves before eliminating the odor. Such a modification would defeat Meiji's object of preserving the cells and Applicant's invention would not be achieved in any event, as there would be no flavor of garlic remaining. SLD ¶16. The result would be an essentially useless non-flavored garlic with greatly reduced nutritive value.

Applicant submits that the Rombauer teachings do not cure the deficiencies in Meiji as a reference. Before that issue is relevant, however, it must first be established that Rombauer and Meiji can be combined according to rules for combining references as set forth in the MPEP and established case law.

Without a suggestion from the prior art, an obviousness rejection is impermissible, as explained in Ex Parte Levengood, 28 USPQ2d 1300, 1301-1302 (TTAB 1993) ("In this case, however, the only suggestion of the isolated teachings of the applied reference improperly stems from the Applicant's disclosure and not from the applied prior art. In In Re Ehrreich, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), at best, the Examiner's comments regarding obviousness amount to assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant's invention because he had the necessary skills to carry out the requisite steps. This is an inappropriate standard for obviousness. See Orthokinetics, Inc. v. Safe Travel Chairs, Inc.,



806, F.2d 1565, 1 USPQ2d 1801 (Fed. Cir. 1986). That which is within the capabilities of one skilled in the art is not synonymous with obviousness. [Citations omitted]. That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic, sound or scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of reference with the claimed invention.”

That the Examiner has fallen prey to hindsight reconstruction is well illustrated on page 3 of the Office Action where it is stated:

Therefore, it would have been obvious to cut the garlic into small pieces as disclosed by Rombauer et al. in the process of Meiji if one wants small pieces or bits of garlic to reduce the flavor without eliminating it.”

But nothing in the cited prior art provides the necessary impetus for wanting small pieces of garlic with reduced, but not eliminated, garlic flavor. That suggestion comes only from Applicant. There is no prior art reference that can be cited that shows Applicant’s end result (with all the limitations in the claims) as a desirable product. All that the Examiner has shown is that once Applicant pointed the way, others could follow. This is precisely what Orthokinetics, Inc. v. Safe Travel Chairs, Inc., *supra*, prohibits.

Applicant has shown that the prior art actually teaches away from its invention (complete deodorization; blanching before cutting) and that to be modified as suggested by the Examiner, Meiji would have to abandon those goals that define its invention. Thus, here, not only is there no suggestion in the prior art for making the claimed combination, the prior art itself

discourages such combination. SLD ¶16.

It is well established that in the absence of a suggestion from the *prior art*, as opposed to Applicant's disclosure, a combination is not a proper grounds for a 103 rejection. As so aptly put in In re Fritch, 23 USPQ2d 1780 (CAFC 1992):

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix [Meiji and Sakamoto] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner . . . Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court had previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”

Thus, Applicant submits that the suggested combination of Meiji and Rombauer is impermissible as a matter of law and the rejection based thereon should not be applied to the newly submitted claims.

Even if the combination is attempted, it would hardly be necessary for Meiji to consult Rombauer to know that garlic can be sliced. If there was any impetus for Meiji to slice the garlic rather than keeping it whole, it would not require Rombauer to teach that to Meiji. Meiji does not slice its garlic because everything Meiji wants to achieve would be upset by doing so. The only possible suggestion for Meiji to use the slicing step taught by Rombauer to produce thin pieces of garlic (sliced from whole garlic cloves of different sizes)

of generally uniform thickness which:

- are crispy and crunchy;
- have a roasted flavor;
- are sized to be stored and dispensed from a shaker;
- imbue foods to which they are applied with garlic flavor; and
- have a generally uniform strength of garlic flavor that is reduced from the strength of garlic flavor of the raw garlic from which they are derived,

comes from Applicant, certainly not from any suggestion found in the prior art that has been cited.

### **Conclusion**

Applicant has submitted seven new claims to replace the claims previously submitted and, in doing so, has placed the application in condition for allowance for all of the reasons stated above. Accordingly, the amendments, Declaration of John Layous and the arguments should be entered.

Respectfully submitted,

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